

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of : Henrik Przybilla, et al.
For : DIGITAL RIGHTS MANAGEMENT
UNIT FOR A DIGITAL RIGHTS
MANAGEMENT SYSTEM
Serial No. : 10/577,087
Filed : April 24, 2006
Art Unit : 3685
Examiner : James D. Nigh
Att. Docket : AT03 0059 US1
Confirmation No. : 1182

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated April 19, 2010.

I. REAL PARTY IN INTEREST

The party in interest is NXP B.V., by way of an Assignment recorded at Reel 019719, frame 0843.

II. RELATED APPEALS AND INTERFERENCES

Following are identified any prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal:

NONE.

III. STATUS OF CLAIMS

Claims 8-27 are on appeal.

Claims 8-27 are pending.

Claims 1-7 are canceled.

No claims are withdrawn.

No claims are allowed.

Claims 8-27 are rejected.

Application No: 10/577,087
Attorney Docket No: AT03 0059 US1

IV. STATUS OF AMENDMENTS

All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following summary refers to the specification of the present application by paragraph numbers and line numbers.

The subject matter recited in independent claim 8 includes: “A digital rights management (DRM) system comprising: a DRM server device [Fig. 1: 1, paragraph [0046], line 1] that issues digital rights objects (DROs) [paragraph [0003], line 12] representing permission to use associated digital data objects (DDOs) [paragraph [0003], lines 14-15]; a DRM user device [Fig. 1: 2, paragraph [0047], line 1] that receives the DROs from the DRM server device [Fig. 1: 1]; and a plurality of DRM client devices [Fig. 1: 3, paragraph [0048], line 1] granted permission by the DRM user device [Fig. 1: 2] to use a specific DDO, wherein each DRM client device [Fig. 1: 3] further comprises: a data storage unit [Fig. 1: 32] that stores the associated DDOs on the basis of DROs stored in the DRM user device [Fig. 1: 2], a first authentication unit [Fig. 1: 31] that authenticates the DRM client device [Fig. 1: 3] by the DRM user device [Fig. 1: 2], and a rights interface [Fig. 1: 33] that requests access to the DROs associated with the DDOs stored in said data storage unit [Fig. 1: 32].”

The subject matter recited in independent claim 9 includes: “A digital rights management system comprising: a plurality of DRM client devices [Fig. 1: 3, paragraph [0048], line 1] that store digital data objects (DDOs); a DRM server device [Fig. 1: 1, paragraph [0046], line 1] that issues digital rights objects (DROs) [paragraph [0003],

line 12] representing permission to use associated DDOs [paragraph [0003], lines 14-15]; and a DRM user device [Fig. 1: 2, paragraph [0047], line 1] that receives the DROs from the DRM server device [Fig. 1: 1], wherein said DRM user device [Fig. 1: 2] further comprises: a second authentication unit [Fig. 1: 21] that authenticates the plurality of DRM client devices [Fig. 1: 3]; a rights storage unit [Fig. 1: 23] that stores DROs received from the DRM server device [Fig. 1: 1], wherein said DROs are accessed by an authenticated DRM client device [Fig. 1: 3] to get permission to use an associated DDO stored on said DRM client device [Fig. 1: 3]; and a second interface [Fig. 4: 24, paragraph [0053], line 1] that receives the DROs from the DRM server device [Fig. 1: 1] and grants usage rights for the associated DDO stored on an authenticated DRM client device [Fig. 1: 3].”

The subject matter recited in independent claim 10 includes: “A digital rights management (DRM) method performed in a DRM system, said DRM system comprising a plurality of DRM client devices [Fig. 1: 3, paragraph [0048], line 1] that store digital data objects (DDOs) [paragraph [0003], lines 14-15], a DRM server device [Fig. 1: 1, paragraph [0046], line 1] that issues digital rights objects (DROs) [paragraph [0003], line 12] representing permission to use associated DDOs, and a DRM user device [Fig. 1: 2, paragraph [0047], line 1] that interacts with said DRM client devices [Fig. 1: 3] and said DRM server device [Fig. 1: 1], said method comprising the steps of: authenticating, by the DRM server device [Fig. 1: 1], the DRM user device [Fig. 1: 2] to

transfer a requested DRO from said DRM server device [Fig. 1: 1] to said DRM user device [Fig. 1: 2] after successful authentication; authenticating a plurality of DRM client devices [Fig. 1: 3] to said DRM user device [Fig. 1: 2]; determining, by the DRM user device [Fig. 1: 2], whether to grant permission to use a specific DDO to different DRM client devices [Fig. 1: 3]; and when permission is granted, transferring usage rights from said DRM user device [Fig. 1: 2] to said DRM client devices [Fig. 1: 3] after successful authentication to permit use of the specific DDO.”

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

- A. On pages 6 and 7, the Office Action rejects claims 10 and 21-27 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.
- B. On pages 7-9, the Office Action rejects claims 8, 9, and 16-20 under 35 U.S.C. § 112, second paragraph as allegedly indefinite.
- C. On pages 9-15, the Office Action rejects claims 8-11, 13-16, 18-20, and 24-26 under 35 U.S.C. § 103(a) as allegedly unpatentable over Pub. No. US2004/0103812 to Messerges ("Messerges") in view of Pub. No. US2004/0117440 to Singer et al ("Singer").
- D. On pages 15-18, the Office Action rejects claims 12, 17, and 21-23 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer, further in view of Pub. No. US2003/0236978 to Evans et al ("Evans").
- E. On pages 18 and 19, the Office Action rejects claim 27 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer, further in view of U.S. Patent No. 5,629,980 to Stefik et al ("Stefik").

VII. ARGUMENT

A. Rejection of Claims 10 and 21-27 Under 35 U.S.C. § 101

On pages 6 and 7, the Office Action rejects claims 10 and 21-27 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

On page 7, the Office Action alleges that *In re Bilski* established a rule that a “tie to a particular apparatus, for example, cannot be mere extra-solution activity.” In response, Appellant respectfully submits that the Examiner’s characterization of *In re Bilski* is incomplete, at least because it only refers to the first page of that decision. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). Regarding “extra-solution activity,” footnote 14 of *In re Bilski* relied upon on prior decisions: *In re Schrader*, 22 F.3d 290, 294 (Fed. Cir. 1994) (holding a simple recordation step in the middle of the claimed process incapable of imparting patent-eligibility under § 101); *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989) (holding a pre-solution step of gathering data incapable of imparting patent-eligibility under § 101).

Appellant respectfully submits that the Office Action’s conclusion is improper as it fails to specifically define the alleged “extra-solution” activity, or to match the facts in *Schrader* or *Grams*. Instead, page 7 of the Office Action presents a conclusory statement, declaring that “e.g. authenticating the DRM user device to the DRM server device” is “representative” of extra solution activity. The use of a single alleged

example is not believed to follow the guidance that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *In re Bilski*, 545 F.3d at 956.

Appellant respectfully submits that the machine-or-transformation test was improperly applied in the rejection. “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a **particular machine or apparatus**, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d at 954 (emphasis added). Here, claim 10 is tied to several examples of a “particular machine or apparatus”: a DRM system, a plurality of DRM client devices, a DRM server device, and a DRM user device. The Office Action fails to comply with *In re Bilski* by failing to ascertain whether any of these items are particular machines. Moreover, there is absolutely no legal support for the Examiner’s position on page 3 that the preposition “by” is statutory while the preposition “with” is non-statutory. It should be noted that “by” and “with” are synonyms and there is no reason to make the change (e.g. see Merriam Webster: “using the means or agency of <was able to finish the project *with* her help> — see **BY**”).

B. Rejection of Claims 8, 9, and 16-20 Under 35 U.S.C. § 112, ¶2

On pages 7-9, the Office Action rejects claims 8, 9, and 16-20 under 35 U.S.C. § 112, second paragraph as allegedly indefinite.

First, the Examiner alleges that the scope of claim 8 “cannot be ascertained.”

According to MPEP § 2173.06, where there is a great deal of confusion about the interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art (emphasis added). As stated by *In re Steele*, 305 F.2d 859 (C.C.P.A. 1962), “a rejection under 35 U.S.C. § 103 should not be based on considerable speculation about the meaning of terms employed in a claim.” Thus the prior art rejection contradicts this rejection.

On page 2, the Examiner incorrectly applies legal precedents related to “recitations of intended use,” failing to consider that a patent Appellant is free to recite features of an apparatus functionally. “We take the characterization “functional” . . . to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what it *does* . . . In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims.” *In re Swineheart*, 439 F.2d 210, 212 (C.C.P.A. 1971) (emphasis added).

Second, the Office Action alleges that claims 8 and 9 recite “both an apparatus and a method.” In response, Appellant respectfully submits that the Examiner has incorrectly applied the law because no alleged method steps are even identified for either claim. Thus, these claims do not present a single claim which claims both an apparatus and the method steps of using the apparatus. See *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384 (Fed. Cir. 2005) and *Ex parte Lyell*, 17 U.S.P.Q.2d 1548 (B.P.A.I. 1990).

C. Rejection of Claims 8-11, 13-16, 18-20, and 24-26 Under 35 U.S.C. § 103(a)

On pages 9-15, the Office Action rejects claims 8-11, 13-16, 18-20, and 24-26 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer.

In response, Appellant respectfully submits that these rejections fail to comply with MPEP § 2142 and have not presented a *prima facie* case of obviousness. Analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit, as "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006). See also *KSR*, 550 U.S. 398 (2007) (quoting Federal Circuit statement with approval). In this case, the Office Action is replete with conclusory statements and lacks any articulated reasoning that possesses the legally required rational underpinning.

As set forth in MPEP § 2143.03, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). Here, the Office Action repeatedly ignores words in the claims, alleging that they are either "intended use" or "non-functional descriptive material." The Examiner fails to present any support for these allegations, instead solely relying upon conclusory statements.

As set forth in MPEP § 2111, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art

would reach. *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999). In this case, the rejection's interpretation is unreasonable because it assumes that any language "does not distinguish the claimed invention from the prior art" without specifically addressing all of the claim language. There is no support for the Examiner's repeated omissions of relevant claim language.

As set forth in MPEP § 2111.02, "the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim." *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). Here, the rejection entirely ignores the preamble, assuming, without any justification, that it has no impact on the scope of the claims.

Also, during examination, "statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference ... between the claimed invention and the prior art. If so, the recitation serves to limit the claim." *In re Otto*, 312 F.2d 937, 938 (C.C.P.A. 1963) (emphasis added). Appellant respectfully submits that no such evaluation is presented.

For the reasons listed above, Appellant respectfully submits that independent claims 8, 9, and 10 are allowable over the references of record.

Claims 11, 13, 14, and 15 depend from claim 8. Claims 16, 18, 19, and 20

depend from claim 9. Claims 24, 25, and 26 depend from claim 10. Thus, claims 11, 13-16, 18-20, and 24-26 are allowable at least due to their respective dependencies from allowable base claims. Therefore, Appellant respectfully requests withdrawal of the rejections of claims 8-11, 13-16, 18-20, and 24-26 under 35 U.S.C. § 103(a).

D. Rejection of Claims 12, 17, and 21-23 Under 35 U.S.C. § 103(a)

On pages 15-18, the Office Action rejects claims 12, 17, and 21-23 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer, further in view of Evans.

Appellant respectfully submits that Evans fails to remedy the deficiencies of Messerges in view of Singer. Claim 12 recites “a **second** revocation list storage unit” (emphasis added). Similar subject matter appears in claim 17.

On page 16, the Office Action fails to address this subject matter, instead referring to “updating a revocation list remotely.” Appellant respectfully submits that the claim language is not equivalent to the Office Action’s interpretation. Moreover, the Office Action does not identify a second revocation list storage unit in Evans.

Claim 23 recites “performing **mutual authentication** of the DRM server device and the DRM user device” (emphasis added). On page 17, the Office Action correctly concedes that Evans does not explicitly teach this subject matter. The Office Action then alleges that “installation of authenticators” would have been a “predictable result” of Evans. In response, Appellant respectfully submits that the alleged teachings of

Evans that are related to “distributed” authentication are not equivalent to the recited subject matter of “mutual” authentication because Evans would not necessarily require both the server and user devices to respectively authenticate each other.

Claim 12 ultimately depends from claim 8. Claim 17 ultimately depends from claim 9. Claims 21-23 ultimately depend from claim 10. Thus, claims 12, 17, and 21-23 also are allowable at least due to their respective dependencies from allowable base claims. Therefore, Appellant respectfully requests withdrawal of the rejections of claims 12, 17, and 21-23 under 35 U.S.C. § 103(a).

E. Rejection of Claim 27 Under 35 U.S.C. § 103(a)

On pages 18 and 19, the Office Action rejects claim 27 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer, further in view of Stefik.

Appellant respectfully submits that Stefik fails to remedy the deficiencies of Messerges in view of Singer, as described above.

Claim 27 recites: “defining each DRO as either transferable or non-transferable” (emphasis added). On page 18, the Office Action correctly concedes that neither Messerges nor Singer teach that a DRO can be transferable. The Office Action then attempts to remedy this admitted deficiency by relying upon Stefik’s alleged teaching of transferable DROs. However, Appellant respectfully submits that the claim language is related defining the state of a DRO. The Office Action presents no evidence that Stefik, or any other reference, defines a DRO, thereby indicating whether

is transferable or non-transferable.

Claim 27 depends from claim 10. Thus, claims 27 is also allowable at least due to its dependency from an allowable base claim. Therefore, Appellant respectfully requests withdrawal of the rejections of claims 27 under 35 U.S.C. § 103(a).

CONCLUSION

For at least the reasons discussed above, Appellant respectfully submits that the rejections are in error and that claims 8-27 are in condition for allowance. Therefore, Appellant respectfully requests that this Honorable Board reverse the rejections of claims 8-27.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062.

Respectfully submitted,
KRAMER & AMADO, P.C.

Date: July 6, 2010


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VIII. CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1-7. (Canceled)

8. (Previously Presented) A digital rights management (DRM) system comprising:
a DRM server device that issues digital rights objects (DROs) representing permission to use associated digital data objects (DDOs);
a DRM user device that receives the DROs from the DRM server device; and
a plurality of DRM client devices granted permission by the DRM user device to use a specific DDO, wherein each DRM client device further comprises:
a data storage unit that stores the associated DDOs on the basis of DROs stored in the DRM user device,
a first authentication unit that authenticates the DRM client device by the DRM user device, and
a rights interface that requests access to the DROs associated with the DDOs stored in said data storage unit.

9. (Previously Presented) A digital rights management system comprising:
a plurality of DRM client devices that store digital data objects (DDOs);

a DRM server device that issues digital rights objects (DROs) representing permission to use associated DDOs; and

a DRM user device that receives the DROs from the DRM server device, wherein said DRM user device further comprises:

 a second authentication unit that authenticates the plurality of DRM client devices;

 a rights storage unit that stores DROs received from the DRM server device, wherein said DROs are accessed by an authenticated DRM client device to get permission to use an associated DDO stored on said DRM client device; and

 a second interface that receives the DROs from the DRM server device and grants usage rights for the associated DDO stored on an authenticated DRM client device.

10. (Previously Presented) A digital rights management (DRM) method performed in a DRM system, said DRM system comprising a plurality of DRM client devices that store digital data objects (DDOs), a DRM server device that issues digital rights objects (DROs) representing permission to use associated DDOs, and a DRM user device that interacts with said DRM client devices and said DRM server device, said method comprising the steps of:

authenticating, by the DRM server device, the DRM user device to transfer a requested DRO from said DRM server device to said DRM user device after successful authentication;

authenticating a plurality of DRM client devices to said DRM user device;

determining, by the DRM user device, whether to grant permission to use a specific DDO to different DRM client devices; and

when permission is granted, transferring usage rights from said DRM user device to said DRM client devices after successful authentication to permit use of the specific DDO.

11. (Previously Presented) The system of claim 8, wherein the DRM user device further comprises:

a second authentication unit; and

a first revocation list storage unit that stores a revocation list of DRM client devices, wherein the second authentication unit checks the revocation list during authentication of each DRM client device.

12. (Previously Presented) The system of claim 11, wherein the DRM server device further comprises:

a second revocation list storage unit that updates the revocation list stored in

the first revocation list storage unit in the DRM user device.

13. (Previously Presented) The system of claim 8, wherein the DRM server device further comprises:

a third authentication unit that performs mutual authentication with a second authentication unit in the DRM user device.

14. (Previously Presented) The system of claim 8, wherein the DRM user device further comprises:

a second interface that receives the DROs from the DRM server device after the DRM user device is authenticated and grants usage rights for the associated DDO stored on an authenticated DRM client device.

15. (Previously Presented) The system of claim 8, wherein each DRO represents exactly one permission to use the associated DDO.

16. (Previously Presented) The system of claim 9, wherein the DRM user device further comprises:

a first revocation list storage unit that stores a revocation list of DRM client devices, wherein the second authentication unit checks the revocation list during

authentication of each DRM client device.

17. (Previously Presented) The system of claim 16, wherein the DRM server device further comprises:

a second revocation list storage unit that updates the revocation list stored in the first revocation list storage unit in the DRM user device.

18. (Previously Presented) The system of claim 9, wherein the DRM server device further comprises:

a third authentication unit that performs mutual authentication with the second authentication unit in the DRM user device.

19. (Previously Presented) The system of claim 9, wherein the DRM server device determines a limited number of supported DRM clients that can access the DDOs prior to issuing the DROs to the DRM user device.

20. (Previously Presented) The system of claim 9, wherein each DRO represents exactly one permission to use the associated DDO.

21. (Previously Presented) The method of claim 10, further comprising:

storing a revocation list of DRM client units in the DRM server device, wherein a second authentication unit in the DRM user device checks the revocation list during authentication of each DRM client device.

22. (Previously Presented) The method of claim 21, further comprising:
 - using the DRM server device to update the revocation list stored in the DRM user device.
23. (Previously Presented) The method of claim 10, further comprising:
 - performing mutual authentication of the DRM server device and the DRM user device.
24. (Previously Presented) The method of claim 10, further comprising:
 - receiving the DROs from the DRM server device with an authenticated DRM user device; and
 - granting usage rights for the associated DDO stored on an authenticated DRM client device.
25. (Previously Presented) The method of claim 10, wherein each DRO represents exactly one permission to use the associated DDO.

26. (Previously Presented) The method of claim 10, further comprising:
determining, with the DRM server device, a limited number of supported DRM clients that can access the DDOs.

27. (Previously Presented) The method of claim 10, further comprising:
defining each DRO as either transferable or non-transferable.

IX. EVIDENCE APPENDIX

A copy of the following evidence 1) entered by the Examiner, including a statement setting forth where in the record the evidence was entered by the Examiner, 2) relied upon by the Appellant in the appeal, and/or 3) relied upon by the Examiner as to the grounds of rejection to be reviewed on appeal, is attached:

NONE.

X. RELATED PROCEEDINGS APPENDIX

Copies of relevant decisions in prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal are attached:

NONE.